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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/797,494
Filing Date: March 10, 2004
Appellant(s): REISINGER, KATRIN

STEVEN H. NOLL
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 21, 2008 appealing from the Office action mailed March 17, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents:

5,535,127	UNO, ET AL.	7-1996
5,852,813	GUENTHER, ET AL.	12-1998

Other Publications:

Microsoft Technet: *Memory*, Jan. 21,2005, accessed Apr. 5, 2007, available at <http://technet2.microsoft.com/WindowsServer/en/library/7da85c6a-1e0a-439e-be35-eb795dce29ec1033.mspx?pf=true>

U.S. Postal Service, *Minutes of the Mailers' Technical Advisory Committee*, Dec. 10-11, 1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uno, et al., U.S. Pat. No. 5,535,127 (Reference A of the PTO-892 part of paper no. 20070404) in view of Guenther, et al., U.S. Pat. No. 5,852,813 (Reference B of the PTO-892 part of paper no. 20070404) and U.S. Postal Service, *Minutes of the Mailers' Technical Advisory Committee*, Dec. 10-11, 1997 (Reference U of the PTO-892 part of paper no. 20070921) (hereinafter "USPS Minutes").

As per claim 1, Uno teaches a mail-processing device comprising: a programmable memory having a table stored therein containing a plurality of codes (column 1, line 19; Fig. 36); a program memory containing an operating program (column 5, line 23); a working memory having mail-item-related data values stored therein (column 5, line 25); a keyboard having a plurality of operating elements allowing manual entry of said mail-item-related data values for said mail item into said working memory (column 5, line 44); a microprocessor in communication with said programmable memory, said program memory, said program memory, said working

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memory, and said keyboard (column 5, line 21); said programmable memory, said working memory and said microprocessor, in combination, being programmable by said operating program to set an operating mode for automatic code entry (column 5, lines 48-50); and said microprocessor being programmed in said operating mode to evaluate said mail-item-related data values stored in said working memory and to automatically select an applicable code from among said plurality of codes stored in said table stored in said programmable memory (column 5, lines 29-40; column 15, lines 1-6, Table). Uno does not teach the operating program is to generate print data for a franking imprint to be printed on a mail item that includes said applicable code; taught by Guenther (column 3, lines 31-35; column 5, lines 45-47). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in order to provide robustly franked mail pieces fully prepared for mailing (as taught by Guenther; column 5, lines 31-37). Uno in view of Guenther does not explicitly teach the codes are product codes; which is taught by USPS Minutes (page 11, Parcel Barcode Clarification). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of USPS Minutes into the device taught by Uno in view of Guenther because product codes are useful to eliminate special service labeling requirements (as taught by USPS Minutes; page 11, Parcel Barcode Clarification).

As per claim 2, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Uno further teaches said table in said programmable memory comprises a plurality of columns, each of said columns comprising a plurality of rows, and including first and second columns containing datasets representing defaults for valid shipping parameters (Fig. 26), and wherein said microprocessor is programmed for row-by-row searching through said first and second columns to identify datasets in said first and second columns corresponding to said values stored in said working memory and, for the valid shipping parameters represented by said datasets,

said microprocessor evaluating structures in remaining columns of said table (column 15, lines 1-4; column 16, lines 59-67; Fig. 37).

As per claim 3, Uno in view of Guenther and USPS Minutes teaches the device of claim 2 as described above. Uno further teaches a display device connected to said microprocessor (column 1, line 53) and wherein said microprocessor is supplied with a weight selected from the group consisting of an entered weight and a measured weight (column 4, line 15), and wherein said table is a first table stored in a first memory range of said programmable memory (column 5, lines 28-30), said programmable memory having further memory ranges in which further tables are respectively stored (column 7, lines 31-32; while Examiner recognizes that Uno does not explicitly use the term "range," it is noted that memory inherently is comprised of multiple address ranges, Microsoft TechNet: *Memory*, printed 4/5/2007, Reference U of the PTO-892 part of paper no. 20070404), including a weight table for determining a table index assigned to different weights (column 7, lines 51-65), and a product code table for determining a product code assigned to said table index (column 21, lines 15-35), and wherein said microprocessor is programmed for storing a start address of said first table in said programmable memory (column 5, lines 28-29), for generating a screen image for shipping parameters associated with said values stored in said working memory and for displaying said screen images on said display device (column 1, line 53), and for accessing said tables in said programmable memory for evaluating data values in a row of said first table in said programmable memory, said data values corresponding to the values stored in said working memory (column 1, lines 51-52; column 22, lines 34-50) and designating, to said product code table, designated product codes (column 22, lines 45-50), and said microprocessor being programmed for storing the product codes designated with the table index for said weight (column 22, line 51). Guenther further teaches that the designating is done by a pointer (column 24, lines 66-67). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno

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in view of Guenther and USPS Minutes in order to reference a further data set (as taught by Guenther; column 24, line 67 - column 25, line 1).

As per claim 4, Uno in view of Guenther and USPS Minutes teaches the device of claim 2 as described above. Uno further teaches a display device connected to said microprocessor (column 1, line 53) and wherein said microprocessor is supplied with a weight selected from the group consisting of an entered weight and a measured weight (column 4, line 15), wherein said table is a first table stored in a first memory range of said programmable memory (column 5, lines 28-30), said programmable memory having further memory ranges in which further tables are respectively stored (column 7, lines 31-32; while Examiner recognizes that Uno does not explicitly use the term "range," it is noted that memory inherently is comprised of multiple address ranges, see Microsoft TechNet: *Memory*), including a weight class table for determining a table index assigned to a weight class code stored in a further memory (column 7, lines 51-65; Fig. 36), and a product code table for determining a product code assigned to said table index (column 21, lines 15-35), and wherein said microprocessor is programmed for storing a start address of said first table in said programmable memory (column 5, lines 28-29), for generating a screen image for shipping parameters associated with said values stored in said working memory and for displaying said screen images on said display device (column 1, line 53), and for accessing said tables in said programmable memory for evaluating data values in a row of a table in said programmable memory, said data values corresponding to the values stored in said working memory (column 1, lines 51-52; column 22, lines 34-50) and designating, to said product code table, designated product codes (column 22, lines 45-50), and said microprocessor being programmed for storing the product codes designated with the table index for a weight class in which said weight occurs (column 22, line 51; Fig. 36). Guenther further teaches that the designating is done by a pointer (column 24, lines 66-67). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught

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by Uno in view of Guenther and USPS Minutes in order to reference a further data set (as taught by Guenther; column 24, line 67 - column 25, line 1).

As per claim 5, Uno in view of Guenther and USPS Minutes and Guenther teaches the device of claim 4 as described above. Uno further teaches a receiver unit (column 5, line 41). The limitation "for loading and storing table values and data for entry into at least one of said table, said weight table, said product code table and said weight class table" is merely a statement of intended use and is only given patentable weight inasmuch as it implies structural limitations to the claim, which are met by the teachings of Uno (column 5, line 41).

As per claim 6, Uno in view of Guenther and USPS Minutes teaches the device of claim 4 as described above. Uno further teaches an interface adapted for connection to the postage meter machine (column 1, lines 18-21), and wherein said working memory temporarily stores at least one of said weight class code and said product code in respective memory areas (column 7, lines 51-63). Guenther further teaches wherein said microprocessor is programmed to transmit at least one of said weight class code and said product code to the postage meter machine via said interface (column 10, lines 30-34). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes in order to calculate the postage (as taught by Guenther; column 10, line 31).

As per claim 7, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Uno further teaches an interface in communication with said microprocessor (column 5, line 44). The limitation for setting said operating mode is a statement of intended use and is only given patentable weight to the extent that it imparts structural limitations to the invention, which are met by the teachings of Uno (column 5, line 44).

As per claim 8, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Guenther further teaches wherein one of said operating elements of said keyboard, when actuated, sets said operating mode (column 13, lines 12-13). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes because keyboard actuation can be used to initiate device functionality (as taught by Guenther; column 13, lines 12-13).

As per claim 9, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Uno further teaches a receiving unit connected to said programmable memory (column 5, line 46). The limitation for loading said table is merely a statement of intended use and is only afforded patentable weight to the extent that it imparts structural limitations on the invention, which are met by the teachings of Uno (column 5, line 46).

As per claim 10, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Uno further teaches wherein said receiver unit is a modem selected from the group consisting of analog modems and digital modems (column 5, line 46).

As per claim 12, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Guenther further teaches wherein said receiving unit is a chip card reader adapted to receive a chip card having a memory in which said table is stored (column 7, lines 1-3). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes to allow mobility for the mail processing system (as taught by Guenther; column 7, line 4).

As per claim 14, Uno teaches a computer-readable medium encoded with a data structure for a mail-processing device having a programmable memory (column 1, line 19), a working memory (column 5, line 25) and a microprocessor programmed to

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operate in an operating mode for automatic code entry (column 5, lines 21, 48-50), and having a receiver unit in communication with the microprocessor (column 5, line 26), said data structure comprising a plurality of memory areas in which are stored (column 5, lines 24-30), respectively, an application program for said automatic code entry (column 22, lines 45-51) and for generating screen images for shipping parameters on a display device (column 1, line 53), at least one first table in one of said memory areas and respective further tables in further memory areas to which access is enabled by said application program (column 7, lines 51-65; column 21, lines 15-35), said first table comprising columns of data values for valid shipping parameters (column 15, Table), and a weight table (column 7, lines 51-65), a code table (column 15, Table; column 21, lines 15-35) and a weight class table (column 7, lines 51-65; Fig. 36), all of said tables being loadable from computer-readable into said programmable memory via said receiver unit (column 5, lines 46-47). Uno does not teach that there are pointers to the data; taught by Guenther (column 24, lines 66-67). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the medium taught by Uno in order to reference a further data set (as taught by Guenther; column 24, line 67 - column 25, line 1). Uno in view of Guenther does not explicitly teach the codes are product codes; which is taught by USPS Minutes (page 11, Parcel Barcode Clarification). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of USPS Minutes into the medium taught by Uno in view of Guenther because product codes are useful to eliminate special service labeling requirements (as taught by USPS Minutes; page 11, Parcel Barcode Clarification).

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uno, et al. in view of Guenther, et al. and USPS Minutes as applied to claim 9 above, in further view of Official Notice.

As per claim 11, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Uno does not explicitly teach wherein said receiving unit

is a drive device adapted to receive a data carrier on which said table is stored, selected from the group consisting of CDs and DVDs. Official Notice was previously taken and considered admitted prior art that it is old and well-known in the art for drive devices to receive data from CDs and DVDs employed as storage data carriers. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the device taught by Uno in view of Guenther and USPS Minutes because CDs and DVDs are reliable data storage media commonly used to transfer data between devices.

As per claim 13, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Uno does not explicitly teach wherein said receiving unit is a memory stick interface adapted to receive a memory stick having a memory in which said table is stored. Official Notice was previously taken and considered admitted prior art that it is old and well-known in the art for drive devices to receive data from memory sticks employed as storage data carriers. It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the device taught by Uno in view of Guenther and USPS Minutes because memory sticks are reliable data storage media commonly used to transfer data between devices.

(10) Response to Argument

A. Appellant's arguments with respect to the current use of product codes are unpersuasive.

Appellant argues that it would not have been obvious to incorporate product code entry into a franking machine despite its explicit disclosure in the USPS minutes reference for two reasons. Appeal Brief, 5. First, the use of a product code is not currently required by the United States Postal Service (although product codes are currently used in other countries—see Appeal Brief, 4). Second, because the USPS has not provided any information to manufacturers of franking equipment as to how a

product code should be entered to meet the approval of the USPS. However, the test used to determine that a claimed invention is obvious is not whether it is required to be in use or even currently in use. The test is whether or not the claimed invention as a whole would have been obvious to one having ordinary skill in the art at the time of invention. See MPEP § 2142 (discussing the legal concept of obviousness under § 103(a)). A *prima facie* case of obviousness is set forth in the rejections above based upon the explicit disclosure of product codes in the USPS minutes, and Appellant's discussion of the actual use of product codes in the United States is not sufficient to rebut it.

B. Appellant's arguments with respect to the combination of Uno and Guenther are unpersuasive.

Appellant argues that Uno's filing dates of 1994 and 1993 "are much too early for the subject matter disclosed in that reference to have any applicability whatsoever to entering a product code in a postage meter machine . . . because product codes did not even exist at the time the application was prepared . . ." Appeal Brief, 6. As shown in the rejections above, the majority of the elements of the claimed invention are disclosed in Uno. Only slight modification to the hardware elements in Uno's mail processing device would be necessary to provide the metering function of Guenther, and to modify the Uno's code entry to be suitable for product codes. Moreover, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). Appellant has made no such showing.

Uno's modification with teachings from the Guenther reference is also disputed, because Uno is directed to processing mail that already has stamps while Guenther's disclosure is concerned with franking mail pieces for mailing. Appeal Brief, 6-7. However, both of these references are plainly within the same specific field of mail piece processing. Additionally, Uno recognizes that some mail pieces will need to be marked

"postage due" because they lack sufficient funds for delivery (col. 4, lines 50-51). The addition of Guenther's meter would result in a recognizably improved system that would avoid the problem of insufficient postage preventing delivery of mail pieces. This addition would merely be a combination of old elements, wherein no element would serve a function other than it already did independently. One skilled in the art of mail processing would have recognized that this combination could be implemented through routine engineering producing predictable results.

C. The combined references are not the product of impermissible hindsight.

Appellant alleges that the rejections are the result of hindsight reasoning based solely on Appellant's specification. However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the only evidence necessary to come to the ultimate legal conclusion of obviousness is plainly in the references themselves. It would only be a matter of routine engineering to adding Guenther's metering functionality into Uno's mail processing system (as stated above). It would also be a simple matter of substitution to modify the code entry system of Uno in view of Guenther to accommodate the product codes disclosed in USPS Minutes (see below).

In response to this position, Appellant states that the above statement of law is not applicable to this case, because the USPS Minutes reference itself "is overwhelming evidence of the long standing but unsolved need that exists in this particular field for a way to enter product codes into a franking imprint . . ." Appeal Brief, 12. Examiner respectfully disagrees. USPS Minutes discloses the advantages of product codes and the manner of their use, but makes no references to this alleged "unsolved need."

The automatic entry of product codes would be no different than the entry of any other code in Uno or Guenther. The only difference is the type of code being entered. Mail processing codes such as those disclosed by Uno in view of Guenther and USPS Minutes share similar formats, characteristics, and functions. Thus, the difference between the claimed subject matter and Uno in view of Guenther rests not on any individual element or function but in the very combination itself—that is, in the substitution of the product codes in USPS Minutes for the codes automatically entered in Uno (see col. 15, Table) and Guenther (see col. 5, lines 44-51). The motivation for making this substitution is to take advantage of product codes' usefulness in eliminating special service labeling requirements (USPS Minutes; page 11), and the substitution would yield no unpredictable results. The analysis in the rejections above provides an articulated reasoning supported by rational underpinning in the facts on the record that supports the legal conclusion of obviousness. See *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Finally, any specifics that would serve to demonstrate differences between the codes to such a point to rebut this conclusion are present neither in Appellant's arguments nor in the claims themselves. The claims merely recite automatic entry of a "product code" without any accompanying specifics that would render the teachings of this combination of references deficient. As automatic entry of mail processing codes is old and well-known in the art, and product codes are also old and well-known in the art, the claimed invention is unpatentable under § 103(a).

D. Conclusion.

The rejections above set forth a proper *prima facie* case of obviousness. Appellant has not successfully shown that the references considered together fail to disclose all elements of the claimed invention, nor has Appellant demonstrated that the references are improperly combined. Accordingly, the rejections made under § 103(a) in view of the cited references should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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